Docket JP920000426US1

Appl. No.: 09/892,147
Filed: June 26, 2001

REMARKS

This is a reply to Examiner's Office communication of July 26, 2007. Claims 4-7, 9, 14-17, 19, 21, and 22 are pending in the application.

Previous Actions

In a first Office action of March 15, 2006, Examiner rejected claims 1-20 under 35 USC 102(e) as being anticipated by Esposito et al. (6,587,838). In Reply A of June 15, 2006, Applicant canceled the independent claims, i.e., claims 1 and 11, and added new independent claims 21 and 22 to overcome the rejection. Applicant also canceled claims 2-3, 8, 10, 12-13, 18 and 20 and amended dependent claims 4-7, 9, 14-17 and 19 to conform them to new independent claims 21 and 22.

In a second, non-final, Office action of September 26, 2006, Examiner rejected claims 4-7, 9, 14-17, 19, 21, and 22, under 35 USC 102(e) as being anticipated by Esposito. Applicant amended claims 21 and 22 to make it more clear that the present invention is not anticipated by an arrangement, as claimed, in which there is offering of a hosting service that is offering *merely one* of the claimed hosting service steps.

Present Office Action

Rejections Under 112, second paragraph

The present, non-final Office action indicates claims 12, 21, and 22 rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office action asserts that the basis for the rejection is that claims 21 and 22, recite phrases " to store" and "operable to" and that this language renders the claim unclear, particularly with respect to claim scope.

Claim 12 was previously canceled and claim 21 recites neither "to store" nor "operable to" nor any variants thereof. However, Applicant notes that claims 16 and 22 *do* recite language such as this. Therefore, Applicant assumes the rejection applies to claims 16 and 22, and not claim 21 or canceled claim 12.

Applicant acknowledges that functional limitations should not be *imported* from a specification into a structural claim limitation for an apparatus claim. See, e.g., Schwing GmbH v. Putzmeister Aktiengesellschaft, 305 F.3d 1318 (Fed. Cir. 2002) ("*Viewed as a whole, the*

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prosecution history does not support the district court's adoption of the functional limitation of
"inhibiting radial expansion of the sealing ring." The applicant's remarks describe . . . We
therefore do not consider the applicant's remarks as sufficient to overcome the general rule that
functional limitations should not be read into purely structural claims.").   But this is different

than the matter of a limitation that is *explicit* in an apparatus claim, which is the matter at hand in

the present application.

As to the matter at hand, the Manual of Patent Examining Procedure states:

> *"There is nothing inherently wrong with defining some part of an invention in*
> *functional terms. Functional language does not, in and of itself, render a claim*
> *improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).*
> *A functional limitation must be evaluated and considered, just like any other*
> *limitation of the claim, for what it fairly conveys to a person of ordinary skill in*
> *the pertinent art in the context in which it is used."*

MPEP 2173.05(g), Functional Limitations.

Moreover, the "operable to" and "stored" language of claims 16 and 22 of the present

application provide something more than that of simply a functional limitation. That is claim 16

depends on claim 22, and claim 22 recites not only a system that is operable to do something, it

recites that the system includes "a first application stored on the hosting system and operable as a

first shopping process executing on the host computer system, the first shopping process being

accessible to shoppers by Internet communications, the first shopping process further being

operable to perform a first hosting service step . . ." and goes on to recite an aspect of that step

and others. Thus, what is claimed is clearly:

i) functional descriptive material ("first application . . . operable as a first shopping

process executing on the host computer system"), in combination with

ii) an appropriate computer readable medium ("first application . . . stored on the hosting

system"), that

iii) enables functionality to be realized for a useful, concrete and tangible result (e.g.,

"communicating with a first integration process and a first resource planning process via Internet

communications to transact first sales . . . ."). A claim reciting this sort of arrangement has long

been recognized as proper subject matter and properly limiting. See, e.g. In re Lowry, 32

USPQ2d 1031 (Fed. Cir. 1994).

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Applicant disagrees with the rejection for the reasons stated above. However, in order to expedite allowance of the application and cooperate fully with the Examiner, Applicant herein submits amendments to claims 16 and 22. With entry of the amendment submitted herein for claim 22, the amended claim states, in one relevant part, that the system includes "a first application stored on the host computer system and operating as a first shopping process when executed . . . wherein the executing first shopping process performs a first hosting service step . . . wherein sales are transacted with shoppers for the customers responsive to ones of the hosting service steps being performed on the host computer system." Applicant submits that this amended language states the claims all the more certainly in a clearly limiting fashion that presents a useful, concrete and tangible result.

Prior Art Rejections

It appears from the Office action that claims 4-7, 9, 14-17 and 19 are rejected under 35 USC 102(e) as being anticipated by US Patent 6, 980, 962 ("Arganbright"), while claims 21 and 22 are rejected under 35 USC 103(a) as being unpatentable over Arganbright in view US Patent Application Publication US2001/0056405 (Muyres). Applicant respectfully traverses.

Once again, Applicant gratefully acknowledges that the present Office action was not made final, which presents the opportunity to move the case forward more efficiently. However, once again the references relied upon for the rejection are complex and describe inventions other than that claimed by Applicant. While Applicant thanks the Examiner for indicating which specific parts of the references are relied upon for the rejections, Applicant regrets that the Office action again does not explain the *pertinence* of the specific parts of the reference. Applicant herein makes an effort to clearly and fully respond to the rejections and distinguish the invention over the reference. However, without information about pertinence of the specific parts, Applicants effort is once again impeded.

The present Office action once again divides claim 21 in the present application into six segments, where segment 1 has approximately 75 words, segment 2 has approximately 69 words, segment 3 has approximately 70 words, segment 4 has approximately 126 words, segment 5 has approximately 124 words, and segment 6 has approximately 37 words. To meet the first five segments of this claim, the Office action relies upon a single set of passages in the Arganbright reference having a total of 2600+ words, i.e., citing the same set of passages once for each of the

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first five claim segments. In other words, regarding the pertinence of the cited reference to one 75 word segment of claim 21, for example, the Office action points out parts of the reference that have a combined total of more than 2600 words in length, much of which is nothing more than boilerplate definitions of well-known terms of art. Applicant submits that on its face this indicates the pertinence of the Arganbright reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Further, the same 2600+ part of the Arganbright reference is pointed out in the present Office action for the rejection of each and every claim. Overall, this same set of 2600+ words is pointed out over 20 times in the second Office action. Further, no other parts of the Arganbright reference are pointed out. In addition, the Office action offers no specific explanation about the significance of individual portions of the 2600+ word passage relied upon in the rejection. Applicant submits that on its face this indicates the pertinence of the Arganbright reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Likewise, with regard to the sixth segment of claims 21 and 22, which is 37 words in length in claim 21, for example, the Office action relies upon a 338 word passage of Muyres with no specific explanation about the significance of individual portions of the relied upon passage. Applicant submits that on its face this indicates the pertinence of the Muyres reference is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Based on the above, Applicant submits that the rejections in the current Office action are improper and respectfully requests that if the amended claims set out herein are not allowed, the current Office action be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*.

Applicant requests a telephone interview and allowance, verbal guidance or a new, nonfinal Office action

Applicant herein submits a request for telephone interview to either i) receive assurance that the amended claims set out herein are to be allowed, ii) receive verbal guidance as to Examiner's position regarding each of the following specific questions, or iii) receive assurance

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the current Office action will be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the following questions.

> If no allowance is granted, Applicant requests the following specific
> questions be addressed in a telephone interview or in a new Office action:

Regarding the first hosting service step, the claim specifically states that a first shopping process on a data center host computer system and that is accessible to shoppers by Internet communications, communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales. The claim also states that the first resource planning process is on a computer system *host located remotely from the data center*. The claim also states the first integration process is on a host computer system located remotely from the data center.

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed first shopping process that is on a data center host computer system, that is accessible to shoppers by Internet communications and that communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales, where the first shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected first hosting service step being performed on the host computer system?

Note that claim also states that the claimed first integration process is on a *host computer system located remotely* from the data center. What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *first integration process*? What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host* computer system?

Note that the claim also states that the claimed first resource planning process is on a *host computer system located remotely* from the data center. What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *first resource planning*

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process? What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

Regarding the second hosting service step, the claim specifically states that a *second resource planning process* on the data center host computer system communicates with a *production process* via Internet or dedicated link communications, where the selectable shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected second hosting service step being performed on the host computer system.

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications?

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *production process*?

Note that the claim also states that the production process is on a host computer located remotely from the data center. What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

Regarding the third hosting service step, the claim specifically states that a *second integration process* on the data center host computer system couples communications between the first shopping process and the second resource planning process to *transact second sales*, where the third shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected third hosting service step being performed on the host computer system.

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *second integration process* that is on the data center host computer system and that couples communications between the first shopping process and the second resource planning process to transact second sales?

Regarding the fourth hosting service step, the claim specifically states that Internet communications to *transact third sales* are coupled between the second resource planning

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process and a *second shopping process* that is accessible to shoppers by Internet communications, where the fourth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected fourth hosting service step being performed on the host computer system.

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *second shopping process* that is accessible to shoppers by Internet communications and that communicates with the second resource planning process for transacting third sales?

Note that the claim also states that the second shopping process is on a *host computer located remotely* from the data center. What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

Regarding, the fifth hosting service step, the claim specifically states that communications are coupled between the first shopping process and a *third resource planning process* to transact fourth sales, where the fifth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected fifth hosting service step being performed on the host computer system.

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *third resource planning process*?

Note that the claim also states that the third resource planning process is on a *host computer located remotely* from the data center. What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

Regarding the sixth hosting service step, the claim specifically states that communications are coupled between a certain process and a *third shopping process,* that the third shopping process is accessible to shoppers by Internet communications, and that the third shopping process is on a host computer *located remotely* from the data center, where the sixth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected sixth hosting service step being performed on the host computer system .

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What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *certain process* that is coupled to the third shopping process?

Note that the claim also states that the certain process is on a host computer *located remotely* from the data center. What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

What specific process taught by Arganbright or Muyres does the rejection rely upon for the claimed *third shopping process*?

Note that the claim also states that the third shopping process is on a host computer *located remotely* from the data center. What specific host computer system taught by Arganbright or Muyres does the rejection rely upon for this *remotely located host*?

Applicant reiterates that the invention as claimed is not taught or suggested by the art of record.

Arganbright teaches about a first host computer (which may nominally be compared to a "data center host computer") that provides merchant-oriented marketing services, which include something like advertisements, and fulfillment services, which includes accounting for sales compensation to merchants in a variety of unusual ways. In addition, the data center host computer provides ordinary consumer-oriented portal-like hosting features, such as home page and e-mail hosting, search services, and links to merchants or service providers, of whom many different types are mentioned. Applicant acknowledges that in this context it is understood that there are host computers for the respective merchants, each of which provide web-based access to their merchant's actual products or services, and acknowledges that these respectively associated host computers are remotely located from the data center host computer, which provides marketing and fulfillment services.

However, neither Arganbright nor Muyres, nor their combination, teach or suggest processes on the data center host performing a specifically recited set of six hosting service steps, as stated in claims 21 and 22, wherein the customers (merchants) select from among the six hosting service steps for performance by the host computer system to transact sales with shoppers. Also in the context of some of these claimed hosting service steps, the claim recites communications between processes to transact sales, some of which are specifically recited as

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being on the data center host and some of which are specifically recited as being on the remote host. The claim also recites that two of the processes are shopping processes, one of which the claim recites is on the data center host, one of which the claim recites is on the remote host, and each of which the claim recites is accessible to shoppers by Internet communications.

It does not appear that Arganbright or Muyres or their combination teach what is claimed, even according to the above very general description of what is claimed. Further, neither Arganbright nor Muyres nor their combination teach or suggest an integration process on a host computer system for coupling a shopping process and a resource planning process on the host computer system, as claimed. Further, neither Arganbright nor Muyres nor their combination teach or suggest service offering selections in which processes on remote hosts are integrated with processes hosted on a central host and other service offering selections in which corresponding processes on the central host are both hosted *and* integrated, as claimed.
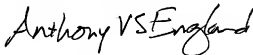
For at least these reasons, Applicant submits that claim 21 is patentably distinct. Claim 22 has similar language, according to the form of the invention it claims. Therefore, Applicant submits that claim 22 is likewise patentably distinct. Claims 4-7, 9, 14-17 and 19 are allowable at least because they depend on allowable claims 21 or 22.

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REQUESTED ACTIONS

For the reasons explained herein above, Applicant contends that the claims as amended herein are patentably distinct and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

In addition, as stated herein above, Applicant herein submits a request for telephone interview to either i) receive assurance that the amended claims set out herein are to be allowed, ii) receive verbal guidance as to Examiner's position regarding each of the following specific questions, or iii) receive assurance the current Office action will be withdrawn and a new Office Action be issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the following questions.

Respectfully submitted,

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Attachment: Applicants Written Request for Interview